UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,462	02/25/2000	Markus Lautenbacher	SEIM0023U/US	7313

7590   10/12/2004

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EXAMINER
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ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/513,462	LAUTENBACHER, MARKUS
	Examiner	Art Unit	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>24 June 2004</u> .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1 and 3-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1 and 3-15</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

Response to Arguments

1.   In view of the Appeal Brief filed on June 24th, 2004, PROSECUTION IS HEREBY

REOPENED. A new action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a

supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or

other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.   Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts.

Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply,

involve, use, or advance the technological arts fail to promote the "progress of science and the

useful arts" and therefore are found to be non-statutory subject matter. For a method claim to

pass the muster, the recited method must somehow apply, involve, use, or advance the

technological arts.

In the present case the inventive concept in claim 11 is directed to software product. It,

However, fails to clearly disclose what type of software product being claimed and fail to

produce a useful concrete and tangible result. Therefore deemed to be directed to non-statutory

subject matter.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 5-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Krishman et al

(U.S. PG Pub no. 2001/0011254).

6.   As per claim 5, Krishman et al teaches usage processing server comprising a usage

processing module for processing a software product downloaded from a network, and wherein

usage processing data required to perform usage processing are delivered to the usage processing server wherein the usage processing server is contacted by the software product after the software product has been downloaded into a terminal device of a user and has been activated, and wherein the usage processing data required to perform usage processing are delivered to the processing server (*see figs 2, 3, summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59*).

7.   As per claims 6, Krishman et al teaches a usage processing server further comprising: a data store in which a software product identification of the software product and type of usage processing data that prescribe a type of usage processing of the software product are stored by the usage processing module, and wherein the usage processing module registers the software product (*see figs 2, 3, summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59*).

8.   As per claims 7, Krishman et al teaches a usage processing server wherein: the usage processing data required comprises a software product identification of the software product and a user identification (*see figs 2, 3, summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59*)).

9.   As per claims 8, Krishman et al teaches a usage processing server wherein the usage processing comprises performing an access control (*see figs 2, 3, summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59*).

10.   As per claims 9, Krishman et al teaches a usage processing server wherein: the usage

processing comprises performing a usage charging of the software product on user accounts and

provider accounts (*see figs 2, 3, summary of the invention and column 6 lines 44-7 lines 43, 8

lines 33-12 line 59).*

11.   As per claims 10, Krishman et al teaches a usage processing server according to claim 5,

wherein the usage processing module keeps statistics about usage contacts that have taken place

and about results of a processing of the usage contacts (*see figs 2, 3, summary of the invention

and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59).*

12.   As per claims 11 and 14, Krishman et al teaches a software product comprising a

software component that is activated when called by the software product and that subsequently

starts communicating with a usage process server and delivers usage processing data required for

performing usage processing to the usage processing server in the framework of the

communication wherein the usage processing server is operated, wherein the usage processing

server is operated by a network provider (*see figs 2, 3, summary of the invention and column 6

lines 44-7 lines 43, 8 lines 33-12 line 59).*

13.   As per claims 12, Krishman et al teaches a software product wherein the usage

processing data comprises: software product provider data; and software product identification;

and wherein the usage processing data is dynamically determined user data (*see figs 2, 3,*

summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59).

14.   As per claims 13, Krishman et al teaches a software product wherein the software

component interacts with the user to produce the dynamically determined user data (*see figs 2, 3,*

summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59).

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

16.   Claims 1, 3, 4, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Krishman et al (U.S. Patent No. 6,073,124) in view of Ahmad (U.S. Patent No. 5,925,127).

17.   As per claims 1 and 15, Krishman et al teaches a method of using software products that

are offered via a network comprising inquiring about a software product from an offer server by

a user via a terminal device downloading the software product from the offer server via the

network onto the terminal device in response to the inquiry of the user activating a software

component of the software product starting a communication by way of the software component

with a usage processing server regarding a usage of the software product in response to a call of

the software product in the terminal device of the user, providing, by the software component in

a framework of the communication, data to the usage processing server (*see figs 2, 3, summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59*). Krishman et al fails to teach an inventive concept of checking the data, by the usage processing server, and then making a determination selected from the group consisting of: whether usage of the software product is approved with respect to the inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts. However, Ahamad teach an inventive concept of checking the data, by the usage processing server, and then making a determination selected from the group consisting of whether usage of the software product is approved with respect to the inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts (*see fig 3, column 9 line15-12 line 10*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krishman et al's inventive concept to include Ahamad's inventive concept and checking the data, by the usage processing server, and then making a determination selected from the group consisting of: whether usage of the software product is approved with respect to the inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts because this would have facilitate software application provider to monitor the usage of their software application usage thereby increase the revenue of the provider.

18.   As per claim 3, Krishman et al teaches a method further comprising operating the usage processing and the offer server by a network provider (*see figs 2, 3, summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59*).
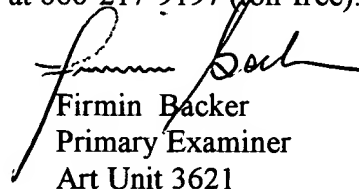
19.   As per claims 4, Krishman et al teaches a method further comprising using a web server

for a server selected from the group consisting of the offer server and the usage processing server

(*see figs 2, 3, summary of the invention and column 6 lines 44-7 lines 43, 8 lines 33-12 line 59*).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The

examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Firmin Backer
Primary Examiner
Art Unit 3621

October 4, 2004